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IN THE

Supreme Court of the United States

OCTOBER TERM, 1975.

No. 75-863

CHICAGO RAWHIDE MANUFACTURING COMPANY
Petitioner,

vs.

CRANE PACKING COMPANY,
Respondent.

OPPOSITION OF RESPONDENT TO MOTION TO EXPEDITE CONSIDERATION OF PETITION AND TO CONSOLIDATE CASES ON APPEAL

and

BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI.

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TABLE OF CONTENTS.

PAGE

I. Opposition of Respondent to Motion to Expedite Consideration of Petition and to Consolidate Cases on Appeal i

II. Brief in Opposition to Petition for Certiorari 1

A. The Petition Is Based Upon Incorrect Assertions 2

B. The "Questions Presented" Are of No Substance 5

C. Petitioner's Description of Its Alleged Invention Is Inaccurate 7

D. Petitioner's "Reasons" for the Writ Are of No Substance 7

Conclusion 9

TABLE OF AUTHORITIES.

Cases.

Graham v. John Deere Co., 383 U. S. 1 ..... 3, 6

Statutes.

28 U. S. C. 1254(1) 1

28 U. S. C. 103 .....1, 3, 6, 8

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I.

OPPOSITION OF RESPONDENT TO MOTION TO EXPEDITE CONSIDERATION OF PETITION AND TO CONSOLIDATE CASES ON APPEAL.

Respondent is unable to find any questions common to this case and to *Sakraida* v. *Ag Pro Inc.*, No. 75-110, to justify consolidating the two cases. To be sure, both are patent cases, but there the similarity ends. This case involves none of the following questions raised in *Sakraida:*

There is no new combination of old elements in this case, but rather, as will be pointed out in respondent's arguments against granting the writ, an old combination of two seal elements which is disclosed in the prior art and to which the standard of invention set forth in *Graham* v. *Deere* was meticulously and correctly applied by both the Trial and Appeal Courts.

There is no issue of overclaiming as in *Sakraida.*

There is no issue of newly discovered evidence, the admission of which was denied so as to leave in doubt the validity of a patent upheld by a Court of Appeals, which issue may have been the sole reason for granting certiorari in *Sakraida*.

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II.

BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI.

This is a routine patent infringement suit in which the District Court (McLaren, J.) held the Hatch patent invalid for "obviousness" under 35 U. S. C. § 103. The Court of Appeals unanimously affirmed (opinion by Judge Stevens, now Mr. Justice Stevens).

This case does not merit the attention of this Court. No question of public importance and no conflict of decision is presented. The case has no significance beyond the particular facts and parties involved.

Respondent agrees that this Court has jurisdiction to consider the Petition, by virtue of 28 U. S. C. § 1254(1).

The "Questions Presented" by the petitioner find no basis in the record of this case. They are hypothetical and do not warrant this Court's consideration. As stated, the case and the issues are routine. None of the important reasons for granting

a Petition for a Writ of Certiorari, as set out in Rule 19 of this Court, exists in this case.

Petitioner's "Statement of the Case" suffers from the same defect. The "facts" asserted to create a question of material interest do not exist. In this brief we shall so demonstrate.

ARGUMENT.

A. The Petition Is Based Upon Incorrect Assertions.

There is nothing in the record to substantiate petitioner's assertion (Pet. 4) that its Hatch *patent* was "highly regarded". Nor is there any evidence that any license under the patent was granted or even sought by anybody.

There is nothing in the record to support petitioner's assertion (Pet. 5) that its Hatch patent claimed a "new" combination of seal elements. It is this assertion on which its petition rests, and this assertion is false.

The Hatch seal is a combination of only two elements. The Court of Appeals described it as "a simple combination of a metal ring and a rubber ring" (App. 3). The metal ring has a right-angled seat. The rubber ring cross section is shaped like a parallelogram (known as a "Belleville" washer) (App. 3, 5).

The Court of Appeals pointed out that the concept of a "simple juxtaposition of a rubber ring and a metal sealing ring" was revealed by the prior Duo Cone seal (App. 5). The Court then referred to the other prior art as follows (App. 5):

> "Combinations of a metal ring containing an angled rear seat with a rubber washer shaped like the one used by Hatch has been used on more than one occasion before."

In footnote 6 at the end of the quoted sentence the Court refers to "Payne No. 2,855,226 (Fdgs. 23-24); Dardin [Durdin] No. 1,862,887 (Fdg. 27); see also Krug No. 2,289,274 (Fdg. 30)." Each one of these refutes petitioner's assertion that the Hatch patent claimed a "new" combination.

Not only was the Hatch combination old, but each of the elements of the combination was old and they cooperated together in the same way as the elements in respondent's prior Payne '226 seal to produce a two piece end face seal (App. 32). Respondent's Payne seal used a Belleville washer made of an "incompressible" and "deformable" material (this includes rubber), in an angled seat in a metal ring (App. 32-33). Hatch used a Belleville washer made of rubber in an angled seat in a metal ring.

A question for the Trial Court to decide was whether rubber was an obvious material to use in place of Teflon. The Trial Court correctly held that it was (App. 32). The Court of Appeals affirmed (App. 14, ftnote 21).

In determining the question of "obviousness", the Court of Appeals pointed out (App. 5) that the District Court followed to the letter the directions of this Court in the *John Deere* case 383 U. S. 1, 17, in considering the "obviousness" issue of a combination of old mechanical elements under § 103. In the *John Deere* case, this Court said:

> "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined."

In the case at bar the Court of Appeals said (App. 5):

> "The district court's conclusion that the Hatch invention was obvious was reached after making an accurate and detailed determination of the scope and content of the prior art, considering the differences between that art and the Hatch claims, and concluding that the level of skill in the rotary seal art was 'quite high' at the time of the Hatch invention since both plaintiff and defendant were then aware of the advantages of the Duo Cone assembly."

The Court of Appeals summarized the District Court's ruling under § 103 as follows (App. 5):

> "Based on the prior use of such a washer ["Belleville"] and a right angled rear seat on a metal ring, together with the simple concept illustrated by Duo Cone, the district judge concluded that the Hatch patent lacked the inventiveness required by § 103; he said that the determination of obviousness was 'based on clear and convincing evidence' "*

The Court of Appeals concluded (App. 13):

> "We accept the district judge's conclusion that, after the significant breakthrough achieved by the Duo Cone seal, it was obvious for a person skilled in the art to experiment with a configuration employing a Belleville washer and a metal ring with a right-angled seat opposed to another right angle to compress the rubber ring upon installation of the seal and, therefore, that the Hatch device does not disclose the degree of inventiveness required by § 103."

The Court of Appeals' analysis of the prior art demonstrates the falsity of petitioner's assertion (Pet. 6) that ". . . nowhere did the prior art suggest the new combination which comprised a Belleville washer and a right-angled metal ring . . .". Furthermore, the claims of the Hatch patent do not call for a "right-angled" metal ring. Thus claim 1 merely calls for "generally" axially and radially directed surface portions defining a "rearwardly opening seat" (App. 78). The metal ring in Payne '226 fits that language (App. 32-33).

The foregoing excerpts from the Court of Appeals' opinion show the error in petitioner's assertion (Pet. 7) that ". . . the 'Payne patent' . . . was not sufficiently significant to have been included in the prior art relied upon by the District Court for invalidating the patent."

A further unfounded assertion by petitioner (Pet. 2) is that the prior art relied upon by the respondent in this litigation is "no different from that considered by the Patent Office".

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* Petitioner says (Pet. 8) that "the 'clear and convincing showing' . . . was actually non-existent." This is another instance of an incorrect factual assertion by petitioner. The prior art and the expert testimony thereon are clear and convincing evidence, as both Courts below recognized.

The Court of Appeals, however, said with respect to uncited Payne (App. 6, 14):

> "A patent issued in 1958 (Payne '226) taught the use of a mating ring supported upon a frusto-conical member. This was the first patent discussed in detail in the district court's analysis of the prior art. It was one of the two patents which one of the inventors of Hatch described, before the Hatch application was filed, as 'the patents of most concern.' Unquestionably, it was relevant prior art, but it was not cited to the Patent Office."
>
> • • • • •
>
> "Certainly Payne '226 should have been cited. We are not persuaded that it was an irrelevant reference because it described a Belleville washer made of Teflon rather than rubber. Nor do we find any merit in the suggestion that the examiner was presumptively aware of Payne '226 since other Payne patents were cited. Nor do we condone what we assume was a lack of diligence in failing to cite prior art which one of the inventors recognized as highly pertinent before the application was filed. [Footnotes omitted].

The foregoing statements by the Court of Appeals show the falsity of petitioner's claim (Pet. 2) that the prior art relied upon by the Court of Appeals in this litigation is "no different from that considered by the Patent Office." Payne '226 was not cited by the Patent Office (App. 80). Nor was it cited to the Patent Office (App. 6).

B. The "Questions Presented" Are of No Substance.

Petitioner's first question (Pet. 2), whether "The Trilogy" sets forth the proper standard of non-obviousness under § 103 for all types of patents, including combination patents, is not a question of substance. "The Trilogy" was not decided with respect to any particular type of patent, but rather with respect to all patents, including combination patents, whose validity was challenged on the ground of obviousness. As previously mentioned, the tests set forth there were closely followed by the Courts below in the present case.

Petitioner's second question (Pet. 2) is likewise of no substance. There is no doubt that a new and useful combination of elements can be non-obvious and patentable even though each of the individual elements is old, but that is not the case here, as both Courts below found.

Petitioner's third question (Pet. 2) is whether the Court of Appeals properly decided this case on the particular evidence in this record. The petitioner's four subpoints relating to evidence are without merit:

(a) The prior art in the case was different from that considered by the Patent Office. We have heretofore shown that the relevant Payne patent '226 was not cited by or to the Patent Office. The Court of Appeals said (App. 14): "Nor do we find any merit in the suggestion that the examiner was presumptively aware of Payne '226 since other Payne patents were cited."

(b) The District Court did not say that the differences between the patented subject matter and the prior art were "not insubstantial." The Court made the statement only with respect to the Duo Cone seal (App. 48); it did not make this statement with respect to the much closer Payne '226 seal. The Court also implied that the Hatch seal "was not significantly different from the Duo Cone seal" (App. 70).

(c) While the Court of Appeals acknowledged that the patented subject matter constituted an "advance in the art," the Court nevertheless held that the Hatch subject matter was obvious in view of the prior art and "therefore that the Hatch device does not disclose the degree of inventiveness required by § 103" (App. 13).

(d) With respect to alleged commercial success and failure of others, this Court in *John Deere* designated them secondary conditions which "might be utilized" (p. 17). The Court of Appeals in the present case thoroughly considered commercial success (App. 10-12) and concluded ". . . since there appears

to have been no effort to market Duo Cone generally, the commercial success of the Hatch seal does not necessarily demonstrate its non-obviousness in the light of Duo Cone". There was here no failure of others prior to Hatch. The earlier Duo Cone seal, as petitioner's witness admitted, accomplished the three essential functions described in the Hatch patent (App. 5, ftnote. 5). Respondent's effort to design around the Hatch patent came *after* Hatch (App. 70).

C. Petitioner's Description of Its Alleged Invention Is Inaccurate.

Petitioner ignores respondent's Payne '226 patent and the prior Durdin and Krug patents in its description of the Hatch seal (Pet. 5). The metal ring with angled seat and Belleville washer were old in Payne '226. Hence, petitioner's statement (Pet. 6) "But nowhere did the prior art suggest making the new combination which comprised a Belleville washer and a right angle seat metal ring instead of the old combination of a torus and a horizontal 'V' ramp metal ring" is incorrect because that combination was suggested by Payne '226 and Durdin.

Petitioner persists in its incorrect categorization of the Hatch seal as a "new" combination in its discussion headed "The Decisions in Error" (Pet. 7). It states ". . . the two courts decided that the Hatch seal was a 'new combination' but of 'old elements' . . .", but nowhere in the Court of Appeals decision is any such decision made. The Court of Appeals never referred to the Hatch seal as a "new" combination, nor do we find any such statement in the opinions or findings of Judge McLaren.

D. Petitioner's "Reasons" for the Writ Are of No Substance.

Petitioner's first "reason" for the writ (Pet. 8) is to give "a balancing technical perspective" to the Court in considering this case and the *Sakraida* case, No. 75-110. It is submitted that

the offered "perspective" is unnecessary to this Court and of no substance. Petitioner adds (Pet. 8) that another "reason" for the writ is that "the issue involved is non-obviousness in a combination patent." The existence of this routine issue, properly decided by the Courts below, presents nothing warranting the granting of the writ.

The second "reason" advanced by the petitioner (Pet. 8-9) is the alleged issue of whether § 103 "applies equally to all patents." As stated above, this issue is without substance.

Finally, petitioner urges (Pet. 9) that the writ should be granted because the Court of Appeals affirmed the District Court's statement that obviousness exists if the differences between the patented subject matter and some of the prior art could be found in any other of the prior art. The Court of Appeals' opinion shows, beyond cavil, that the Court of Appeals did not base its affirmance upon this one statement by the District Court. The Court of Appeals' opinion also shows that a fair reading of the District Court's opinion establishes that the District Court considered *all* of the prior art under § 103, including Duo Cone, Payne, Durdin and Krug, and concluded that the combination of Hatch was obvious. This routine conclusion on the evidence in this case, affirmed by the Court of Appeals, does not warrant another hearing in this case.

CONCLUSION.

Since no substantial questions meriting review and no special and important reasons for review have been presented, the petition should be denied.

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